IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application:

Appl. No.	:	10/736,998	) Examiner: Wu, R.
Applicant	:	Mark Bresnan, et al.	
Filed	:	December 16, 2003	
Confirmation No.	:	5759	
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Customer No.	:	00919	
Date	:	May 20, 2009	) Group Art No.: 3628

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellants submit the following Brief in response to the Notice of Appeal filed in this case on March 12, 2009, following a Final Office Action mailed December 12, 2008. A Pre-Appeal Brief Conference request was filed with the Notice of Appeal, and the corresponding Notice of Panel Decision was mailed April 24, 2009.

The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885.

<u>TABLE OF CONTENTS</u>

This Brief contains these items under the following headings and in the order set forth below:

I. **REAL PARTY IN INTEREST**

The real party in interest in this appeal is Pitney Bowes Software Inc., a Delaware corporation, the assignee of this application.

II. **RELATED APPEALS AND INTERFERENCES**

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. **STATUS OF CLAIMS**

Claims 1-3, 6-25, 27-32, 35-53 and 55-57 are the subject of this Appeal.

Claims 52, 53, and 55-57 stand rejected under 35 U.S.C. § 101 as being unpatentable because the claimed invention is allegedly directed to a non-statutory subject matter.

Claim 30 stands rejected under 35 U.S.C. § 112 second paragraph, on the grounds that the claims fail to particularly pointing out and distinctly claim the subject matter which the applicants regards as the invention.

Claims 1-3, 9-17, 30-32, and 38-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of U.S. Patent 7,236,950 to Savage, et al. ("Savage").

Claims 4, 5, 26, 33, 34 and 54 are cancelled.

Appellants hereby appeal the rejection of claims 1-3, 6-25, 27-32, 35-53 and 55-57

IV.   STATUS OF THE AMENDMENTS

Claims 1-57 were filed with the application on December 16, 2003. In response to an Office Action dated July 25, 2008, a Response, dated October 17, 2008 was filed, amending claims 1, 13, 14, 24, 27, 30, 41, 42, 52 and 55 and canceling claims 4, 5, 26, 33, 34 and 54. In response to the Final Office Action mailed December 12, 2008, claims 7, 8, 30, 36 and 37 were amended and claims 6 and 35 were cancelled in an Amendment After Final Rejection filed on February 3, 2009, these amendments were not entered. The PTO mailed an Advisory Action Before the Filing of an Appeal Brief on February 25, 2009. In response, a Notice of Appeal and an Appeal Brief Conference Request was filed on March 12, 2009.

Therefore, current claims 1-3, 6-25, 27-32, 35-53 and 55-57 are set forth in Appendix A to this Brief.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1

The invention of claim 1 comprises a message processing system for preparing a large quantity of messages to be distributed to recipients. A first component of the system is a consolidator module. The consolidator module receives data corresponding to the plurality of messages to be processed. The consolidator module is programmed to select individual message do be consolidated into a single message package based on predetermined criteria. (Fig.1, Fig 2, Para. 19-20) Exemplary consolidation criteria may include messages to be delivered to the same mailing address, messages having proximal due dates, messages for which the sender and recipient have authorized consolidation, messages for which marketing content is compatible, and messages for which business considerations are compatible. (Para. 41-48)

In a further preferred embodiment, the consolidator module is coupled to a customer relationship management system. The customer relationship management

system is preferably used to determining at least some of the consolidation criteria and for generating a template for consolidated message packages. (Para. 30-33)

The first criteria include marketing business rules that are determined by the customer relationship management system. (Para. 30) The marketing rules determine whether messages that include particular marketing content may be consolidated. (Para. 44-45)

Claim 24

Claim 24 is directed to a message processing system for preparing a plurality of messages to be distributed to customers. The system comprises a consolidator module receiving data corresponding to the plurality of messages. The consolidator module is programmed to consolidate multiple of the plurality of messages into a single message package based on first criteria. (Fig.1, Fig 2, Para. 19-20) Messages for consolidation are selected from the plurality of messages based on the messages including a same delivery address and having due dates proximal in time. (Para. 43) A customer preference is consulted to determine whether consolidation for a particular message is authorized, whereby consolidation is disallowed by the consolidator module if there is no authorization. (Para. 30-33)

Claim 30

Claim 30 is directed to a method for processing and preparing a plurality of messages to be distributed to recipients. Data is received corresponding to the plurality of messages. More than one of the plurality of messages is consolidated into single message packages based on first criteria. (Fig.1, Fig 2, Para. 19-20) At least some of the first criteria is determined through a customer relationship management system wherein the step of determining the first criteria includes marketing business rules determined by the customer relationship management system. (Para. 30-33) Messages are prevented from being consolidated based on the marketing rules that include a rule whether messages that include particular marketing content may be consolidated. (Para. 44 - 45)

Claim 52

Claim 52 is directed to a method for processing and preparing a plurality of messages to be distributed to recipients. The method includes receiving data corresponding to the plurality of messages. More than one of the plurality of messages are consolidated into single message packages based on first criteria. (Fig.1, Fig 2, Para. 19-20) Messages are selected for consolidation from the plurality of messages based on the messages having a same delivery address and having due dates proximal in time. (Para. 43) The step of consolidating further includes determining whether a customer preference authorizes consolidating for a particular message, and disallowing it if there is no authorization. (Para. 44 - 45)

This summary is not intended to supplant the description of the claimed subject matter as provided in the claims with reference to the specification and drawings.

VI.   <u>GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL</u>

Whether claims 52, 53, and 55-57 are patentable under 35 U.S.C. § 101 as the claimed invention is allegedly directed to a non-statutory subject matter. See argument under "**<u>Rejections Under 35 U.S.C. § 101</u>**" below.

Whether claims 30 is patentable under 35 U.S.C. § 112 second paragraph, as being unpatentable on the grounds that the claims fail to particularly pointing out and distinctly claim the subject matter which the applicants regards as the invention. See argument under "**<u>Rejections Under 35 U.S.C. § 112</u>**" below.

Whether claims 1-3, 9-17, 30-32, and 38-45 are patentable under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of U.S. Patent 7,236,950 to Savage, et al. ("Savage"). See argument under "**<u>Rejections Under 35 U.S.C. § 103(a)</u>**" below.

VII.   <u>ARGUMENT</u>

Rejections Under 35 U.S.C. § 101

The Examiner rejected claims 52, 53, and 55-57 under 35 U.S.C. § 101 because the claimed invention are allegedly directed to a non-statutory subject matter.

Independent claim 52 satisfies the "transforms an item" branch of the test enunciated in *In re Bilski*, 88 USPQ2d 1385 (CAFC) (2008). In particular claim 52 recites "consolidating multiple of the plurality of messages into single message packages." Thus, a "plurality of messages" are transformed into "single message packages." For example, an envelope including multiple statements is created instead of multiple envelopes including separate statements. This is clearly a transformation that brings independent claim 52 within patentable subject matter. Accordingly, it is requested that these rejections of claim 52, and its dependent claims be withdrawn.

For these reasons, it is requested that the rejection of claim 52 under § 101 be overturned.

Rejections Under 35 U.S.C. § 112

Claim 30 stands rejected under 35 U.S.C. § 112 second paragraph, on the grounds that the claims fail to particularly point out and distinctly claim the subject matter which the applicants regards as the invention.

A formal error was identified in the December 12, 2008 Office Action and a § 112 rejection was asserted by the Examiner because the word "not" was omitted from claim 30, in a place where clearly should have been based on the context. The Examiner recognized that the claim was intended to read "a rule whether messages that include particular marketing content may not be consolidated," but that the word "not" had been left out. See Para. 10, December 12, 2008 Office Action. Subsequently, the Examiner refused to enter the very amendment that was suggested in the Office Action. Entry of the amendment was also requested via the Pre-Appeal Brief Conference Request. The refusal to enter the amendment by the Examiner and by the panel was incorrect in view of 37 C.F.R. 1.116. Because the meaning of the claim was clear, it is requested that the Examiner's § 112 rejection be overruled and the Appellant be allowed to fix the typographical error by adding the word "not" where it should be. The failure of the

Examiner to eliminate this issue for purposes of appeal reveals a strategy of obstructionism that is generally used when the merits of the arguments are weak on the other issues.

Rejections Under 35 U.S.C. § 103

Rejections Over Schumacher in view of Savage

The Examiner rejected claims 1-3, 9-17, 30-32, and 38-45 under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of U.S. Patent 7,236,950 to Savage, et al. ("Savage").

In connection with, the Examiner stated that Schumacher does not include a system "wherein the marketing rules include a rule whether messages that include particular marketing content may be consolidated," as recited in independent claim 1. The Examiner then relies upon the Savage reference for the proposition that consolidation provides cost advantages. However, Savage fails to disclose, or to suggest, the very thing that the Examiner admits is missing from Schumacher. The claim language is directed to "rules" about whether "particular marketing content may be consolidated." Such rules may dictate that certain content may or may not be consolidated. Savage teaches nothing about such rules, and that claim language has been improperly ignored in making these rejections. Because the "rules" components of the claim have not been disclosed or suggested in either reference, no *prima facie* case of obviousness has been made.

Savage's general teaching of consolidation does not cure the deficiency of Schumacher. It is impermissible for the Examiner to simply state that it would have been obvious to <u>create new elements</u> that are otherwise not found in the prior art. For a prima facie case of obviousness, every element must be found in the prior art. This is not a case of asserting that one of ordinary skill in the art would know to tie the pieces together, as is often argued in view of the *KSR* decision. Rather, no showing of the elements has been made. Accordingly, for at least these reasons, the rejection of claim 1 and its dependent claims 13 and 14 should be withdrawn.

Similarly claim 30 recites a step of "preventing messages from being consolidated based on the marketing rules that include a rule whether messages that

include particular marketing content may be consolidated" (previously recited in claim 34). Once again Savage fails to cure the deficiency of Schumacher. Accordingly, for at least these reasons, the rejections of claims 30 and dependent claims 41 and 42 should be withdrawn.

Rejections over Schumacher in view of Johnson

Claims 6-8 and 35-37 were rejected over Schumacher in view of U.S. Publication No. 2004/0230523 to Johnson ("Johnson"). Claims 6 and 35 have been cancelled and the subject matter has been added to their depending claims 7,8, 36, and 37 respectively. Johnson fails to cure the deficiencies identified above with regard to the Schumacher reference in view of the independent claims.

Further, Johnson does not teach using customer preferences to determine whether consolidation (claims 7, 36) or householding (claims 8, 37) is desired in the first place. The Examiner has asserted that Johnson teaches a preference for receiving a hardcopy document. However, this is not what is recited in the claims, so the reference fails to support a *prima facie* case of obviousness. Accordingly, the rejections of these claims should be withdrawn.

Rejections over Schumacher in view of Stepno

Claims 18-20, 22, 24-26, 28, 46-48, 50, 52 -54 and 56 were rejected over Schumacher in view of U.S. Publication No. 2002/0133472 to Stepno ("Stepno"). Since Stepno fails to cure the deficiencies of Schumacher with regard to independent claims 1, 24, and 30, the corresponding dependent claims should be allowable for the same reasons.

With regard to independent claim 52, the subject matter of claim 54 has now been added to that independent claim. Neither Schumacher nor Stepno discloses or suggests that "the step of consolidating includes determining whether a customer preference authorizes consolidation for a particular message." The Examiner cites known concern for privacy as the motivation for this component. However, the Examiner has still failed to cite a reference that supports using a "customer preference" to authorize consolidation. While privacy a known problem, the Examiner has provided no support for concluding that such a general concept would result in the particular steps recited.

Rejections over Schumacher in view of Stepno and Johnson

Claims 21, 23, 27, 29, 49, 51, 55 and 57 were rejected over Schumacher in view of Stepno and further in view of Johnson. As cited by the Examiner, Johnson only describes offering discounts for making quick payments. The claims recite describing the benefits of householding or consolidation. Thus, the disclosure of Johnson is different that what is recited in the claims, so it is inadequate to serve as a teaching or disclosure of the element for purposes of making a prima facie obviousness rejection. Accordingly, the rejections of these claims should be withdrawn.

Rejections over Schumacher alone

Claims 31 - 33 were rejected over Schumacher. As discussed above, Schumacher fails to disclose or suggest the features recited in independent claim 30. Accordingly, these dependent claims should be allowable for the same reasons.

VIII.   **CONCLUSION**

For the reasons advanced above, Appellants respectfully submit that claims 1-3, 6-25, 27-32, 35-53 and 55-57 are patentable. Reversals of the rejections by the Examiner are respectfully requested.

Respectfully submitted,

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CLAIMS APPENDIX A

What Is claimed Is:

1. A message processing system for preparing a plurality of messages to be distributed to customers, the system comprising:

a consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidating the messages based on first criteria;

a customer relationship management system coupled to the consolidator module, the customer relationship management system determining at least some of the first criteria;

wherein the first criteria include marketing business rules determined by the customer relationship management system; and

wherein the marketing rules include a rule whether messages that include particular marketing content may be consolidated.

2. The message processing system of claim 1 wherein the customer relationship management system determines a template for message packages and the template is transmitted to the consolidator module for forming the message packages.

3.   The message processing system of claim 2 wherein the template includes marketing content developed by marketing tools in the customer relationship management system.

4 -5.   (Cancelled)

6.   The message processing system of claim 1 wherein the first criteria include customer preferences.

7.   The message processing system of claim 6 wherein the first criteria includes a customer preference on whether or not consolidation is desired.

8.   The message processing system of claim 6 wherein the first criteria includes a customer preference on whether or not householding is desired.

9.   The message processing system of claim 1 wherein the consolidator module is coupled to a statement applications processing module, the statement applications processing module determining at least some of the first criteria.

10.   The message processing system of claim 9 wherein the statement applications processing module provides message business data to the consolidator module for forming the message packages.

11.   The message processing system of claim 9 wherein the statement applications processing module receives data from an automated data factory having a plurality of mail production sites.

12.   The message processing system of claim 9 wherein the first criteria include sender rules received from the statement applications processing module.

13.   The message processing system of claim 12 wherein the first criteria include a sender rule whether messages that include particular business content may be consolidated.

14.   The message processing system of claim 12 wherein the first criteria include a sender rule whether messages that include particular business content may be householded.

15.   The message processing system of claim 12 wherein the sender rules include a requirement to maximize throughput of message packages, and whereby the consolidator module forms message packages in order to maximize throughput.

16.   The message processing system of claim 12 wherein the sender rules include a requirement to minimize mail production costs, and whereby the consolidator module forms message packages in order to minimize mail production costs.

17.   The message processing system of claim 1 wherein the consolidator selects messages for consolidation from the plurality of messages based on the messages including a same delivery address.

18.   The message processing system of claim 17 wherein the consolidator selects messages for consolidation based on messages having due dates proximal in time.

19.   The message processing system of claim 18 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

20.   The message processing system of claim 18 wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

21.   The message processing system of claim 20 wherein, if the customer preference does not authorize consolidation, the consolidator generates content to be included in the message that describes benefits of consolidation.

22.   The message processing system of claim 18 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

23.   The message processing system of claim 22 wherein, if the customer preference does not authorize householding, the consolidator generates content to be included in the message that describes benefits of householding.

24.   A message processing system for preparing a plurality of messages to be distributed to customers, the system comprising:

a consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidating the messages based on first criteria, wherein the consolidator module selects messages for consolidation from the plurality of messages based on the messages including a same delivery address and having due dates proximal in time: and

wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

25.   The message processing system of claim 24 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

26. (Cancelled)

27.   The message processing system of claim 24 wherein, if the customer preference does not authorize consolidation, the consolidator generates content to be included in the message that describes benefits of consolidation.

28.   The message processing system of claim 24 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

29.   The message processing system of claim 28 wherein, if the customer preference does not authorize householding, the consolidator generates content to be included in the message that describes benefits of householding.

30.   A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

receiving data corresponding to the plurality of messages;

consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria;

determining at least some of the first criteria through a customer relationship management system: wherein the step of determining the first criteria includes marketing business rules determined by the customer relationship management system; and

including a step of preventing messages from being consolidated based on the marketing rules that include a rule whether messages that include particular marketing content may be consolidated.

31.   The method of claim 30 further comprising the step of determining a template for message packages with the customer relationship management system.

32.   The method of claim 31 wherein the step of determining the template comprises including marketing content developed by marketing tools in the customer relationship management system.

33 - 34. (Cancelled)

35.   The method of claim 30 further including gathering customer preference data and including it in the first criteria.

36.   The method of claim 35 wherein the step of consolidating is controlled based on the first criteria which includes a customer preference on whether or not consolidation is desired.

37.   The method of claim 35 wherein the step of consolidating is controlled based on the first criteria which includes a customer preference on whether or not householding is desired.

38. The method of claim 30 further including the step of determining at least some of the first criteria with a statement applications processing module.

39. The method of claim 38 further including the step of providing message business data from the statement applications processing module for forming the message packages.

40. The method of claim 38 wherein the step of determining at least some of the first criteria includes incorporating sender rules received from the statement applications processing module.

41. The method of claim 40 wherein the step of consolidating is controlled by the first criteria which includes a sender rule whether messages that include particular business content may be consolidated.

42. The method of claim 40 wherein the step of consolidating is controlled by the first criteria which includes a sender whether that messages that include particular business content may be householded.

43. The method of claim 40 wherein the sender rules include a requirement to maximize throughput of message packages, and the step of consolidating is controlled to form message packages in order to maximize throughput.

44.   The method of claim 40 wherein the sender rules include a requirement to minimize mail production costs, and wherein the step of consolidating is controlled to form message packages in order to minimize mail production costs.

45.   The method of claim 30 wherein the step of consolidating includes selecting messages for consolidation from the plurality of messages based on the messages having a same delivery address.

46.   The method of claim 45 wherein the step of consolidating includes selecting messages for consolidation based on messages having due dates proximal in time.

47.   The method of claim 46 wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

48.   The method of claim 46 wherein the step of consolidating includes determining whether a customer preference authorizes consolidating for a particular message, and whereby consolidating is disallowed if there is no authorization.

49.   The method of claim 48 wherein, if the customer preference does not authorize consolidation, further including a step of generating content to be included in the message describing benefits of consolidation.

50.   The method of claim 46 wherein the step of consolidating includes determining whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed if there is no authorization.

51.   The method of claim 50 wherein, if the customer preference does not authorize householding, further including a step of generating content to be included in the message describing benefits of householding.

52.   A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

receiving data corresponding to the plurality of messages;

consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria, wherein the step of consolidating includes selecting messages for consolidation from the plurality of messages based on the messages having a same delivery address and having due dates proximal in time; and

wherein the step of consolidating includes determining whether a customer preference authorizes consolidating for a particular message, and whereby consolidating is disallowed if there is no authorization.

53.   The method of claim 52 wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

54.   (Cancelled)

55.   The method of claim 52 wherein, if the customer preference does not authorize consolidation, further including a step of generating content to be included in the message describing benefits of consolidation.

56.   The method of claim 52 wherein the step of consolidating includes determining whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed if there is no authorization.

57. The method of claim 56 wherein, if the customer preference does not authorize householding, further including a step of generating content to be included in the message describing benefits of householding.

<u>EVIDENCE APPENDIX B</u>

None

<u>RELATED PROCEEDINGS APPENDIX C</u>

None